

C2  
Conced.

improvement comprising openings formed in the frame forming lips homogeneously defined on the frame base of the material thereof and adapted to receive the track flanges, and aligned pairs of openings defined in each of the walls at the corners thereof communicating with the lip-defining openings in the frame base whereby the track flanges are adapted to extend [therethrough] through the openings to permit[ting] said lips and winch frame to be slidably mounted on the track.

5. (Amended) In a winch as in claim 4 wherein said lips comprise first and second spaced parallel lips defined on the frame base, said lips having ends, said openings defined in the wall at the corners being in alignment with said lip ends and the [extended] longitudinal [projection] length of said lips.

#### Remarks

Applicant respectfully requests reconsideration of the rejection in view of the foregoing amendments and following remarks.

The Examiner has rejected claims 5-7 under 35 U.S.C. 112, on the basis that the phrase "the extended longitudinal projection" in claim 5 lacks positive antecedent basis in the claim. Applicant has replaced "the extended longitudinal projection" with "the longitudinal length" to traverse this rejection.

The Examiner has repeated the rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art in Figures 1 and 2 of the present application and the French '619 patent. Summarized, the Examiner's argument is that 1)

the multi-piece welded winch base of prior art Figures 1 and 2 discloses all of the structural recitations of the claims, except that it is not formed from a flat elongated blank; and 2) French '619 generally discloses a winch base folded from a single piece of metal, and "it would have been obvious to one of ordinary skill in the art to make the separate base plates of the acknowledged prior art [from] a monolithic piece by bending the end regions of a flat elongated plate, as taught by French '619".

Argument (1) is the Examiner's structural argument. Before addressing the Examiner's legal argument in favor of combination, applicant submits that the Examiner's structural argument for the §103 rejection is incorrect.

The entirety of the Examiner's analysis of the acknowledged prior art is:

"The acknowledged prior art discloses openings (24) formed in the frame forming lips (20) adapted to receive track flanges (38), and openings (24) defined in the walls (16) of the corners thereof whereby the track flanges (38) may extend therethrough permitting said lips (18, 20) and winch frame to be slidably mounted on the track (34), the lips comprise first (18) and second (20) parallel lips defined on the frame base, said lips (18, 20) having ends, said openings defined in the wall (16) of the corners being in alignment with said lip ends (18, 20) and the longitudinal projection of said lips.

First lip (18) is defined by the first lateral side of the base, a slot (22) defined intermediate the base sides (16), said slot defining the second lip (20), notches (24) defined in the base first lateral side (16) and the wall corners adjacent the base first lateral side (16), said notches defining said openings (24) in alignment with said first lip." Examiner's Final Office Action, pages 2-3.

The primary error in the Examiner's analysis is the comparison of the assembled multi-piece welded structure of prior art Figures 1 and 2 with applicant's claimed slot/notch/end region structure for a flat elongated blank as set forth in Figure 5. This is believed to be an improper hindsight comparison; if the Examiner were to compare the

pieces of prior art Figure 1, disassembled and laid flat, to the claimed flat elongated blank structure in claim 1 and best shown in Figure 5, it would be impossible to find the claimed notches, slots, lips, end regions and other specific structure which allows the flat blank to be folded into a functional winch base. Applicant submits herewith a drawing of the prior art multi-piece welded assembly of Figures 1 and 2, disassembled and laid flat, to illustrate this point.

Additionally, the Examiner's point-by-point listing of the prior art structural features does not follow the claimed structure of claim 1:

*"The acknowledged prior art discloses openings (24) formed in the frame forming lips (20)..."*. Openings 24 do not form lips 20. Openings 24 are simply notches in the side plates or walls 16; they do not "form lips" because they are part of a separate (non-lip forming) piece prior to assembly. In contrast, applicant's notches 54 in the claimed flat blank (see Figure 5) do form lip 56.

*"...And openings (24) defined in the walls (16) of the corners thereof whereby the track flanges (38) may extend therethrough...."* Prior art Figures 1 and 2 show only a single opening 24 in each wall 16; there is no corresponding opening in any portion of the winch base for the second of the two parallel hooks on an LL track. Applicant has amended claims 1 and 4 to clarify the fact that each side wall 16 has plural openings, one for each flange of the LL track.

*"...The lips comprise first (18) and second (20) parallel lips defined on the frame base, said lips (18, 20) having ends, said openings defined in the wall (16) of the corners being in alignment with said lip ends (18, 20) and the longitudinal (length) of said lips."*

This apparently refers to claim 5. However, the "ends" of lips 18, 20 in prior art Figures 1 and 2 extend laterally past and overhang the sidewalls 16 and openings 24, and are not "in alignment" with the openings as claimed. Applicant's claimed openings define the lips; openings 24 in prior art Figures 1 and 2 do not.

*"The first lip (18) defined by the first lateral side of the base...."* This apparently refers to claim 1, but only holds true for the multi-piece welded assembly of prior art Figures 1 and 2 with a hindsight reconstruction of applicant's invention and further by ignoring the "flat elongated plate blank" language of claim 1, since it is impossible to define a "first" lateral side of "the" base in the prior art until the separate pieces are welded together. It also ignores the requirement in claim 1 that the first lip be defined, not only by the first lateral side of the base, but "intermediate" a pair of "spaced notches" defined in the first lateral side. Prior art Figures 1 and 2 does not have such notches; it doesn't need them, because it is a multi-piece assembly, and is not a unitary blank which can be folded to form a base.

*"...A slot (22) defined intermediate the base sides (16), said slot defining the second lip (20)...."* Again, the prior art can only be considered to have "a slot 22 defined intermediate the base sides" based on a hindsight reconstruction after the pieces have been welded together. Even then, this does not meet the language of claim 1, which recites that the slot is defined "intermediate said openings", not merely "the base sides" as argued by the Examiner. This is a tangible structural difference which the Examiner's rejection overlooks. Moreover, the Examiner's proposed "slot 22" in the prior art does not "define the second lip"; and again, applicant's claimed second lip is defined by a slot

"intermediate said openings".

"...Notches (24) defined in the base first lateral side (16) and the wall corners adjacent the base first lateral side (16)...." At this point, the Examiner has used the same reference numeral (24) to "find" three different pieces of applicant's claimed structure in the prior art: "openings (24) formed in the frame forming lips (20)"; "openings (24) defined in the walls (16) of the corners thereof"; and "notches (24) defined in the base first lateral side (16)." Prior art Figures 1 and 2 simply has no "notches" as claimed by applicant in claim 1, and it is improper for the Examiner to apply a single piece of prior art structure 24 in three different ways for the rejection.

Based on the supposed structural identity between the assembled multi-piece winch base of prior art Figures 1 and 2 and applicant's claimed invention (now shown to be incorrect), the Examiner has cited the French '619 patent and several cases (*Detroit Stove Works, in re Keller, in re Preda*) for the proposition that it would have been obvious to "make the separate base plates of the acknowledged prior art of a monolithic piece by bending the blank end regions of a flat elongated plate...." Applicant's invention, however, is not merely the formation of the various pieces of prior art Figures 1 and 2 into a "monolithic piece" and bending it, because that hindsight approach does not result in the claimed invention. Instead, applicant has invented a new structure which lends itself to forming a winch base by bending a flat plate blank. The Examiner's argument that applicant has merely taken a multi-piece structure and formed it from one piece is therefore not supportable, and cases such as *Detroit Stove Works* do not warrant the §103 rejection. For example, in the *Detroit Stove Works* case, a stove for burning one

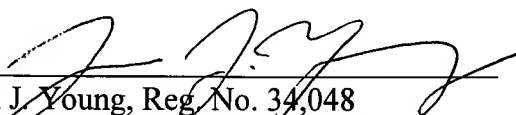
type of fuel, which was normally formed in two pieces, was formed from a single piece in order to burn a hotter type of fuel. There were no structural changes made other than forming the multi-piece structure as a single, integrally cast piece. This is not what applicant has done with the present invention in view of the prior art in Figures 1 and 2. By analogy, in order to allow the manufacture of a one-piece "stove", applicant has come up with an entirely new physical structure which lends itself to one-piece manufacture.

As for the Examiner's other cases, cited for the general proposition that the test for combining references is not what first one and then the other reference discloses individually, applicant points out that the structural differences shown above between the invention and the prior art, *taken as a whole*, are enough to show that the invention is more than an ordinary skill inference drawn from the general prior art teachings that a winch base can be made from a single folded piece as in French '619. More than such an inference is required to come up with the novel notch/opening/slot/fold line structure claimed in claims 1 and 4 and shown in Figure 5.

Applicant therefore submits that the rejection of claims 1-7 under 35 U.S.C. §103 is traversed. Applicant has made a number of amendments to the claims to improve clarity throughout, and to emphasize some of the differences argued above, differences which are already in the claims but perhaps not as clear as they could be.

If the Examiner has any questions about this amendment, he is invited to contact applicant's undersigned attorney at (313) 662-0270 or (248) 649-3333.

Respectfully submitted,

  
Jason J. Young, Reg. No. 34,048  
Thomas N. Young, Reg. No. 20,985

Dated: 11-11-97